

## **ADMINISTRATIVE PANEL DECISION**

**ALSTOM v. Carolina Rodrigues, Fundacion Comercio Electronico**  
Case No. D2022-4321

### **1. The Parties**

The Complainant is ALSTOM, France, represented by Lynde & Associates, France.

The Respondent is Carolina Rodrigues, Fundacion Comercio Electronico, Panama.

### **2. The Domain Name and Registrar**

The disputed domain name <jobsatalstom.com> is registered with GoDaddy.com, LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 14, 2022. On November 14, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 14, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent (Registration Private, Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on November 15, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on November 24, 2022.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on November 25, 2022. In accordance with the Rules, paragraph 5, the due date for Response was December 15, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on December 16, 2022.

The Center appointed Selma Ünlü as the sole panelist in this matter on January 5, 2023. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

#### 4. Factual Background

The Complainant is a French company established in 1928, which operates in the field of power generation, power transmission, and rail infrastructure, develops and markets a complete range of systems, equipment, and services in the railway industry, and has activities around the world. The Complainant owns trademarks containing ALSTOM such as the marks as follows:

- United States of America Trademark No. 75565686 filed on October 9, 1998, in classes 35, 37, 39, 40, 41, and 42;
- United States of America Trademark No. 85250501 filed on February 24, 2011, in classes 9, 12, 35, 37, 39, and 42;
- United States of America Trademark No. 85507365 filed on January 3, 2012, in class 12;
- United States of America Trademark No. 85507371 filed on January 3, 2012, in classes 7, 9, 12, 37, 39, 42, and 45;
- International Registration No. 706292 filed on August 28, 1998, in classes 1, 2, 4, 6, 7, 9, 11, 12, 13, 16, 17, 19, 24, 35, 36, 37, 38, 39, 40, 41, and 42;
- International Registration No. 706360 filed on August 28, 1998, in classes 1, 2, 4, 6, 7, 9, 11, 12, 13, 16, 17, 19, 24, 35, 36, 37, 38, 39, 40, 41, and 42;
- European Union Trademark Registration No. 948729 filed on September 30, 1998, in classes 6, 7, 9, 11, 12, 13, 16, 17, 19, 24, 35, 36, 37, 38, 39, 40, 41, and 42;
- France Trademark No. 98727762 of April 10, 1998, in classes 6, 7, 9, 11, 12, 16, 19, 24, 35, 36, 37, 38, 39, 40, 41, and 42;
- France Trademark No. 98727759 of April 10, 1998, in classes 6, 7, 9, 11, 12, 16, 19, 24, 35, 36, 37, 38, 39, 40, 41, and 42; and,
- France Trademark No. 98727757 of April 10, 1998, in classes 6, 7, 9, 11, 12, 19, 37, 39, 40, and 42.

The Complainant is also the owner of domain names, including the trademark ALSTOM, such as:

- <alstom.com> registered since January 20, 1998;
- <alstomgroup.com> registered since November 14, 2000;
- <alstomgroup.net> registered since June 1, 2017;
- <alstomgroup.fr> registered since June 2, 2017;
- <alstomgroup.eu> registered since November 24, 2018;
- <alstom.com> registered since June 20, 2000;
- <alstom.net> registered since April 1, 2000;
- <alstom.co.uk> registered since June 15, 1998;
- <alstom.info> registered since July 31, 2001;
- <alstom.cn> registered since July 7, 2004;
- <alstom.org> registered since April 1, 2000;
- <alstom.fr> registered since May 10, 2010;
- <alstom.ca> registered since November 25, 2000;
- <alstom.kr> registered since February 28, 2007;
- <alstom.pro> registered since July 23, 2008; and,
- <alstom.careers> registered since April 30, 2018.

The above-mentioned domain names are redirected to the Complainant's group website, "www.alstom.com".

The Complainant also owns several companies and trade names with the denomination “alstom”, such as, ALSTOM Transport Technologies, ALSTOM Transport, ALSTOM Holdings, and ALSTOM Management.

The disputed domain name was registered on September 2, 2022, and engages in a dynamic redirect as further described below in the Complainant’s contentions, and currently redirects to a webpage where there are categories leading to job listings.

## **5. Parties’ Contentions**

### **A. Complainant**

First, the Complainant states that the disputed domain name had reverted to a webpage showing a security warning and encouraging web users to download what they could only assume to be a virus or other dangerous content, and it was indicated that the visitor should call a specified number within five minutes to avoid the computer breaking down. It is then stated that the URL now reverts to a parking page. The Complainant also explains that they tried to contact the Respondent and even the Registrar through their lawyer in September 2022, several times via contact form and email to settle the matter but they received no response.

The Complainant contends that the disputed domain name identically contains the Complainant’s well-known trademark ALSTOM and the addition of “jobsat-” does not prevent a finding of confusing similarity. Furthermore, it is stated that the disputed domain name will be perceived as for a webpage for recruitment at the Complainant. It was also noted that previous UDRP panels have generally considered that the association of a mark and the term “job” within a domain name results in a risk of confusion. The Complainant also asserts that addition of the new generic Top-Level Domain (“gTLD”) “.xyz” does not change the overall impression of the designation as being connected to its trademark and does not differ them. It is claimed that Internet users will directly recognize the Complainant’s trademarks and trade name within the disputed domain name and will believe it belongs to the Complainant. Therefore, the Complainant claims that the disputed domain name is confusingly similar to its ALSTOM trademarks.

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name and the Respondent is not affiliated in any way to the Complainant. Neither license nor authorization has been granted to the Respondent to apply for registration of the disputed domain name by the Complainant. Also, the Respondent has not applied for or obtained any trademark registrations related to the ALSTOM sign.

The Complainant asserts that the disputed domain name completely incorporated the Complainant’s trademark ALSTOM as mentioned above and refers to the past UDRP decisions stating that the ALSTOM trademark is well known. The Complainant states that the Respondent must reasonably be aware that registering the disputed domain name constitutes bad faith. Also, the facts that the disputed domain name reverts to a dangerous webpage and the Respondent has not responded in any way as well as attempts to conceal the identity by anonymously registering the disputed domain name are claimed to be showing the bad faith. It is also contended that the aim for registering the disputed domain name was to damage the reputation of the Complainant. Consequently, the Complainant concludes that the Respondent has registered and is using the disputed domain name in bad faith.

### **B. Respondent**

The Respondent did not reply to the Complainant’s contentions.

## 6. Discussion and Findings

The Complainant must prove that the three elements of paragraph 4(a) of the Policy have been met for the disputed domain name, namely:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

Since the Respondent did not object to any of the contentions from the Complainant by not submitting a Response, the Panel will decide the Complaint in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable and on the basis of the Complaint and supporting Annexes.

### A. Identical or Confusingly Similar

In light of the explanations and evidence provided by the Complainant, the Panel is satisfied that the Complainant has valid trademark rights in the ALSTOM trademark, which is reproduced in its entirety in the disputed domain name. The Panel is of the opinion that the addition of “jobsat” does not prevent the domain name from being confusingly similar to the Complainant’s trademarks.

Furthermore, the addition of the gTLD “.com” does not prevent a finding of confusing similarity, since it is merely a technical registration requirement to be disregarded typically.

Consequently, the Panel finds that the disputed domain name is confusingly similar to the Complainant’s trademarks and the Complainant has satisfied the requirements of paragraph 4(a)(i) of the Policy.

### B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy lists non-exhaustively the relevant circumstances that could show the Respondent’s rights or legitimate interests in a domain name, as follows:

“Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate [the respondent’s] rights or legitimate interests to the domain name for purposes of paragraph 4(a)(ii):

(i) before any notice to [the respondent] of the dispute, [the respondent’s] use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or

(ii) [the respondent] (as an individual, business, or other organization) ha[s] been commonly known by the domain name, even if [the respondent] ha[s] acquired no trademark or service mark rights; or

(iii) [the respondent] is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.”

The Panel notes that the Respondent has not filed a Response, and therefore, neither denied the Complainant’s claims, nor brought any information or evidence to prove any rights or legitimate interests.

The Complainant has made a *prima facie* showing that the Respondent does not have any rights or legitimate interests in the disputed domain name. In particular, the Complainant asserted that the Respondent has no trademarks with the word “alstom” and that it did not provide any license or authorization for the Respondent to use its trademark as part of the disputed domain name.

Since the Complainant made out a *prima facie* case, the burden of production shifts to the Respondent to establish its rights or interests in the disputed domain name. The Respondent, however, has not sought to rebut that *prima facie* case.

Further, the Panel finds that the composition of the disputed domain name, combining “jobsat” with the Complainant’s ALSTOM trademark carries a risk of implied affiliation, misleading unsuspecting Internet users believing the website connected to the disputed domain name to offer career opportunities with the Complainant, contrary to the fact. Accordingly, such composition cannot constitute fair use as it effectively suggests endorsement or ownership on part of the Complainant. Moreover, given the various websites to which the disputed domain name has redirected, including possible malware and pay-per-click advertisements, the Panel finds that such use does not amount to a *bona fide* offering of goods or services.

In light of the Complainant’s assertions and evidence, the Panel finds that the Complainant has met the requirement under the Policy of *prima facie* showing that the Respondent does not have any rights or legitimate interests in the disputed domain name. Accordingly, the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

### **C. Registered and Used in Bad Faith**

Paragraph 4(b) of the Policy lists certain relevant non-exhaustive circumstances, which can be considered as the registration and use of a domain name in bad faith, namely:

“(i) circumstances indicating that [the respondent has] registered or acquired [a disputed] domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of [the respondent’s] documented out-of-pocket costs directly related to the domain name; or

(ii) [the respondent has] registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that [the respondent has] engaged in a pattern of such conduct; or

(iii) [the respondent has] registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, [the respondent has] intentionally attempted to attract, for commercial gain, Internet users to [the respondent’s] website or other on-line location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of [the respondent’s] website or location or of a product or service on [the respondent’s] website or location.”

The Panel must decide by examining all relevant circumstances of each case in question. It is possible that cumulative conditions lead to the finding of bad faith, such as the Complainant’s trademark being well known, and no response submitted to the Complaint.

The disputed domain name incorporates the exact distinctive ALSTOM trademark and trade name of the Complainant, which cannot be considered as a coincidence. The Complainant has provided that the ALSTOM trademark is well known, therefore, the fact that the Respondent decided to register the disputed domain name including this term in its entirety strongly suggests that the Respondent taken the Complainant’s well-known ALSTOM trademark into account and targeted it specifically in order to gain unfair advantage.

As indicated by the Complainant, the fact that the disputed domain name reverted to a dangerous webpage encouraging web users to download viruses cannot be considered use in good faith. Generally, the use of the confusingly similar disputed domain name to mislead Internet users, expecting to find the Complainant,

to various third-party websites is evidence of the Respondent's bad faith registration and use of the disputed domain name.

The Panel considers that the disputed domain name falls under the circumstance (iv) of the paragraph 4(b) of the Policy, namely, "creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of [the respondent's] website" because the disputed domain name seems to be a recruitment website of the Complainant, as in being affiliated to the Complainant if not belonging to it. Considering the Complainant's trademark to be deemed well known, as also previously determined by other panels, the Panel considers that the Respondent knew or should have known the disputed domain name includes the Complainant's well-known trademark and therefore, the registration cannot be in good faith.

See also, *Confédération Nationale du Crédit Mutuel v. Nicola Bazar*, WIPO Case No. [D2013-1572](#):

"Respondent knew or should have known that the Domain Name included Complainant's CREDIT MUTUEL well-known trademark. [...] However, passive holding of the website does not prevent the Panel from finding registration and use in bad faith. The Panel further notes that Respondent undeveloped use of the website at the Domain Name which incorporates Complainant's trademark in its entirety indicates that Respondent possibly registered the Domain Name with the intention to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the trademark of Complainant as to the source, sponsorship, affiliation, or endorsement of its website or location or of a service on its website or location, as per paragraph 4(b)(iv) of the Policy."

Consequently, given the explanations in the Complaint and the evidence provided by the Complainant, the Panel decides that the third requirement is also met and both the registration and the use of the disputed domain name are in bad faith.

## 7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name, <jobsatalstom.com>, be transferred to the Complainant.

*/Selma Ünlü/*

**Selma Ünlü**

Sole Panelist

Date: January 19, 2023